

REMARKS

This amendment is filed in response to the Office Action dated July 23, 2009. In view of these amendment and remarks, this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The claim amendments are supported by throughout the specification, for example, the amendment to claim 44 is supported by the specification at page 11, lines 10 to 14. Claim 37 is amended to correct the dependency. New claims independent claims 60 and 61 further specify embodiments of the invention, and are presented in response to the December 8, 2009 telephone interview with Examiner Wang.

Claims 37 and 44-61 are pending in this application. Claim 37 is withdrawn pursuant to a restriction requirement. Claims 44-59 are rejected. Claims 37 and 44 are amended in this response. Claims 60 and 61 are newly added. Claims 1-36 and 38-43 were previously cancelled.

Interview Summary

Applicant gratefully acknowledges the courtesy of Examiner Wang in granting a telephone interview with the undersigned and Kenneth L. Cage on December 8, 2009. During the interview, Applicant's representative presented an amendment to claim 44. The Examiner indicated that the amendment should overcome the rejection under 35 U.S.C. § 112. Applicant's representative asserted that the present claims are not obvious in view of the Examiner asserted combination of references. The Examiner maintained that the claims were too broad, and suggested Applicant narrow the scope.

Claim Rejections Under 35 U.S.C. § 112

Claims 44-59 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the range "4:1 to 2.1:1" allegedly lacks support

from the application as originally filed. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

It is believed that the range “4:1 to 2.1:1” is supported by the specification. However, in order to advance prosecution of this application claim 44 has been amended to recite “range of 4:1 to 2:1,” which is clearly supported by the specification at page 11, lines 10-14. Applicant submits that the claims fully comport with the requirements of 35 U.S.C. § 112.

Claim Rejections Under 35 U.S.C. § 103

Claims 44-59 were rejected under 35 U.S.C. § 103 (a) over Zabotto et al., U.S. Patent No. 4,673,526 (“Zabotto”) and Barker et al., U.S. Patent No. 5,360,824 (“Barker”) in view of Kellner, U.S. Patent No. 6,042,815 (“Kellner”), McAtee et al., U.S. Patent No. 6,153,208 (“McAtee”), Stewart et al., U.S. Patent No. 6,197,281 (“Stewart”), Geria, U.S. Patent No. 4,992,476 (“Geria”), Daniel et al., U.S. Patent No. 5,891,449 (“Daniel”); and Gagnebien et al., U.S. Patent No. 5,888,951 (“Gagnebien”). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the present invention, as claimed, and the cited prior art.

The present invention is directed to a cosmetic exfoliating composition which is stable and which does not leave a greasy or tacky after-feel when the composition is applied to and rinsed from skin with water and the skin is dried. Specification at p. 4:3-17. The composition is effective to condition the skin of a human being, which produces an exfoliating composition and cleanses the skin. Specification at 4:12-13. The skin effects are superior to the prior art because of the use of water-insoluble monocarboxylic acid salt in combination with emollient fatty material and a controlled proportion of surfactant. Specification at pp. 17:20 –18:36.

According to the present invention:

- The emollient/salt ratio in the composition is required to be in the range of 4:1 to 2:1. Specification at p. 11:10-14. These proportions claimed provide a stable, extrudable paste or cream. Specification at p. 4: 23-24.

- The composition includes 10% to 45% by weight of a non-irritating, mildly abrasive, skin compatible, particulate material to effectively cleanse and lubricate the skin without abrading the skin. Specification at p. 12:26-28. The particulate material in the composition must include both an abrasive material as well as 8% to 20% by weight of a starch material. Specification at p. 12:22-30.

- The claimed range of 0.4% to 8.0% by weight of the amount of surface active agent is essential to the composition to provide the thin film of emollient that effectively softens, smoothes and moisturizes the skin without leaving a greasy or tacky after-feel when the composition is removed from the skin with water and then dried. Specification at p. 10:4-16. It must be controlled within the claimed range so that it is effective to rinse the bulk of the composition from the skin after the composition is applied. *Id.* If too little surfactant is present, too much fatty matter remains on the skin to leave a greasy and unacceptable after-feel. Specification at p. 10:20-21. If too much surfactant is present, substantially all of the composition is removed from the skin when rinsed with water and a thin film of emollient is not left on the skin. Specification at p. 10:21-23. The amount of surface active agent is critical to stabilizing the composition and to leaving a thin film on the skin, but not leaving a greasy or tacky after feel after rinsing with water. Specification at p. 10:4-27.

- The composition must contain a calcium or magnesium salt of a C₁₄-C₁₈ monocarboxylic acid. Specification at p. 4:17-18.

The examiner has failed to present a *prima facie* case of obviousness because the combined teachings of the prior art relied upon by the examiner would not have led a person of ordinary skill in the art to select, add, delete and mix the various ingredients (or claim elements)

disclosed in the prior art in the specific percentages to arrive at the claimed composition such that a person skilled in the art would expect a soft, smooth and moisturized skin without a greasy or tacky after feel after rinsing with water to be provided.

It is the subject matter as a whole that must be considered and the results obtained from the inventive composition, and not the fact that individual constituents of the composition can be identified in the prior art. The error in examiner's rejection is that he has selected key claimed constituents from the prior art, but ignored the fact that the prior art lacks other constituents that would teach one of skill in the art away from the invention.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007) (emphasis added). It is the subject matter as a whole, not the finding of individual limitations in the prior art without an apparent reason to combine the individual limitations into the invention as a whole that must be considered when reaching a determination of obviousness. *KSR* reaffirms the analytical framework set out in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), which mandates that an objective obviousness analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art. *KSR*, 127 S. Ct. at 1734. Secondary considerations such as commercial success, long felt but unresolved needs, or failure of others "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.* ("While the sequence of these questions might be

reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

As evidence of non-obviousness, a 37 C.F.R. §1.132 Declaration of Lauren Trahan, Crabtree & Evelyn’s Formulation Chemist, addressing secondary considerations on non-obviousness, was filed December 31, 2007. A Supplemental Declaration of Mrs. Trahan was also filed on July 1, 2008 addressing the commercial success of the claimed invention. This submission provides compelling evidence of synergy, commercial success and long felt need of the scope of the claims of the subject patent. As discussed below in more detail, such evidence weighs strongly against the finding of obviousness.

Under these guiding principles, the claims of the present application are not obvious in light of the primary references of Zabotto and Barker in view of Kellner, McAtee, Stewart, Geria, Daniel, and Gagnebien.

The Primary References of Zabotto and Barker Are Deficient in Meeting the Limitations of the Claimed Invention

The Examiner acknowledges the many deficiencies in Zabotto and Barker in meeting the claim limitations stating:

“The primary references [Zabotto and Barker] do not teach expressly the particular percentage of each and every ingredient herein claimed, or the employment of particular ingredients, such as particular abrasive agents, particular oil, calcium stearate, or the employment of sodium chloride, pumice, kernel starch as a particulate ingredients, and sodium cocoyl N-methyl taurate as the surfactant.”

Office Action at p. 4 (emphasis added). Even when one of skill in this art combines Zabotto and Barker, the particular percentages of each and every ingredient is not disclosed, much less the employment of particular ingredients. The Examiner's use of "such as" is exemplary only of the deficiencies in the combined references. Importantly, the Examiner omitted the fact that neither Zabotto nor Barker identified calcium or magnesium C₁₄-C₁₈ monocarboxylic salt within the claimed emollient/salt ratio range.

To make up for these deficiencies in Zabotto and Barker, the Examiner then relies on no less than six other references, none of which fully make up for the deficiencies of the particular percentage of the ingredients and employment of particular ingredients of Zabotto and Barker. The Examiner's back-fitting of the deficient claim limitations by selecting, adding, subtraction and mixing of claim elements from eight prior art references can only be attributed to the Examiner's impermissible hindsight use of independent claim 44 as a road map.

This is clear error as the examiner has failed in his attempt to make a *prima facie* case of obviousness as no "apparent reason"¹ is provided why one of skill in the art would select, add, subtract or mix the claim limitations from eight references. *KSR* at 1741. There is no "apparent reason" in the eight prior art references to combine the references in the manner that the Examiner alleges to disclose or teach claims 44-59. One of skill in the art would find multiple and impassable detours to achieve the present invention if one only followed the teachings in the **combination of eight** prior art references.

a. Zabotto Fails To Solve The Deficiency

According to the Examiner, Zabotto teaches a cleansing composition containing 50-95% oily phase, about 1-30% of an emulsifying agent and about 1-10% of particulate abrasives.

¹ The Supreme Court's *KSR* decision requires an "apparent reason" why one of skill in the art would combine known elements to render the invention obvious. *KSR* at 1741.

Office Action at page 3. Zabotto, however, has the following deficiencies in meeting the recited claim limitations:

- The particulate abrasives of Zabotto are described as "hydrosoluble," but are not disclosed to be mildly abrasive, but non-irritating – a limitation required by base claim 44.
- There is no teaching in the reference of mixing a starch with the particulate abrasives, also as required by base claim 44.
- There is also no teaching of adding a calcium or magnesium C_{14} - C_{18} monocarboxylic salt within the claimed emollient/salt ratio range as recited in claim 44 to provide a stable, extrudable paste or cream.
- There is no teaching or suggestion of the claimed range for the emulsifying agent so as to stabilize the composition and leave a thin film of emollient on the skin, without leaving a greasy or tacky after feel after rinsing with water also as required by base claim 44.
- Zabotto states that: "The compositions of the present invention do not dry, thus allowing a prolonged massage, and remain thick or oily as long as water is not added. The lubricating effect of the compositions also makes the massage much gentler and more comfortable than with the presently known compositions." Col. 6:6-11.

b. *Barker Fails To Solve The Deficiency*

Barker also fails to meet numerous claim limitations and has similar deficiencies. Barker's composition is a cream composed of a 50-50 mixture of petroleum jelly and corn oil along with sodium chloride particles. Barker requires that the particulate be water soluble and absorbed by the skin. See col. 2, lines 52-58. Barker is deficient in meeting the claim limitations because:

- Barker is unstable, contrary to the claimed limitation that the composition be “stable.” In fact, Barker illustrates the problem in the prior art exfoliating material. Specifically, in Example 16, specification at p. 23, the composition of Example 1 of U.S. Patent No. 5,360,824 to Barker was reproduced: 20% of sodium particles, 40% corn oil and 40 % VASELINE petroleum jelly. What was found was that the composition separates with the sodium chloride precipitating in less than one hour.

- There is no disclosure or suggestion of composition containing a surface active agent;

- There is no disclosure or suggestion of a calcium or magnesium C₁₄-C₁₈ monocarboxylic salt in the claimed emollient to salt ratio range; and

- There is no disclosure or suggestion a mixture of starch and other particulates as set forth in base claim 44.

To one of skill in the art, the secondary references to Kellner, McAtee, Stewart, Geria, Daniel, and Gagnebien fail to meet the deficiencies of the primary references of Zabotto and Barker

In the Office Action, the examiner fails in his attempt to make a *prima facie* case of obviousness by using the secondary references of Kellner, McAtee, Stewart, Geria, Daniel, and Gagnebien to meet the deficiencies of Zabotto and Barker. The secondary references do not cure the deficiencies in the primary references as each has indicia in their disclosure that would repel one of skill in the art from selectively taking one composition or range of compositions to meet the claimed invention.

c. *Kellner Fails To Solve The Deficiency*

According to the Examiner:

“Kellner teaches water and oil emulsion solid cosmetic compositions. The composition may be up to 30 per cent of emollient oil, both natural and synthetic oil may be employed (see, particularly, col. 9, line 29 to col. 11, line 62. Kellner further discloses that addition emollient materials, such as fatty alcohol, wax, etc., as oil phase gelling agent may be employed up to 30 % (see, particularly, col. 2, lines 66-67; col. 7, line 45 to col. 9, line 26).”

Office Action at p. 4 (emphasis added). The Examiner continued to describe Kellner as follows:

“Kellner further teaches that up to 20% of primary gelling agent may be used, wherein the preferred primary gelling agent are salt of fatty acid, particularly calcium stearate (see col. 2, lines 24-65). Surfactants up to 20% are desirable in the composition. Surfactants, including cationic, anionic, nonionic and zwitterionic surfactants are suitable (see, col. 16, line 9 to col. 19, line 34). The composition may comprise up to 50% of particulate matter, the particulate matter may be organic or inorganic, such as corn starch, mica, etc. (see col. 19, lines 37-61).”

Office Action at p. 4.

Zabotto and Barker are oil based anhydrous cleansing compositions. The rejection relies on Kellner in combination with either Zabotto or Barker as teaching solid, water and oil emulsion cosmetic composition. Office Action at pp. 3-4. However, Kellner is not a stable, extrudable paste or cream cleansing composition as required by base claim 44, rather, it has a consistency such that it can be molded in the form of a stick (col. 2:7-11). Further, Kellner's composition contains a significant amount of water, 5-95% by weight and requires both primary

and secondary gelling agents (col. 1:56 to col. 2:3). The percentage of water in Kellner's composition is higher than that set forth in the claimed composition, 0-4.0%. Also, the amount of emollient oil in Kellner's composition of 0.1-30% is less than the minimum 35% required by base claim 44. Col. 1:65; col. 9:29.

Moreover, a person skilled in the art would not have looked to an **aqueous** (water-based) composition to modify an **anhydrous** (water-free) composition of Zabotto. There would be no reason from the combined teachings of Kellner, Zabotto and Barker to modify either Zabotto or Barker to add a gelling agent to the anhydrous compositions. Further, while Kellner discloses mixtures of starch and other particulates, the reference does not teach or suggest a starch/particulate mixture where 8% to 20% by weight of the 10% to 45% by weight of the particulate material is a starch material selected from the group consisting of starches and enzyme or acid hydrolyzed starches as required by base claim 44.

d. *McAtee Fails To Solve The Deficiency*

The Examiner states: "McAtee disclosed that sodium cocoyl methyl taurate is similarly useful as other anionic surfactant in cleansing composition." Office Action at p. 5.

McAtee is not directed to a cleansing composition in the form of a cream or lotion. It is directed to a dry, disposable multilayered article impregnated with a dry cleansing composition to which water must be added in order to function. In addition, McAtee seeks to solve the problem of lather suppression caused by the addition of ingredients such as surfactants. See col. 1:68 to col. 2:15. Specifically to solve this problem, McAtee uses a combination of "lathering surfactant" and conditioning component in his cleansing composition. See col. 4:61-66. Even though McAtee's composition could contain less than 5% by weight of water (col. 7:63 to col.

8:6), its cleansing properties require the addition of water to the impregnated composition in the multilayered article. See col. 7:7-15.

Also, the multilayered article itself is the exfoliate, and not a mixture of starch and particulate material as required by base claim 44. See col. 7:15-22. McAtee also does not disclose or suggest the addition of calcium or magnesium C₁₄-C₁₈ monocarboxylic salt to the composition as required by independent claim 44. While McAtee broadly discloses a salt of cocoyl methyl taurate as a lathering surfactant, there is no disclosure of the amount of surfactant in the composition impregnated into the multilayered substrate. Claim 2 of the patent discloses the amount to be 0.5% to about 12.5% by weight of the water insoluble substrate, not of the impregnated composition. The disclosure of McAtee is at best a “shotgun” disclosure of many ingredients. None of the examples in the patent are directed to compositions containing a surfactant within the scope of base claim 44.

e. *Stewart Fails To Solve The Deficiency*

The Examiner states: “Stewart et al. teaches that polyvalent soaps, such as calcium stearate are well known to be useful as a thickener fro [for] making oil base gel. See, particularly, col. 9:24-29.” Office Action at p. 5.

Stewart, however, teaches away from the claimed subject matter. Stewart is directed to a sunscreen composition that is waterproof, *i.e.*, the composition is not intended to be rinsed off with water after it is applied to remove the composition from the skin. See col. 3:50-53. Accordingly, a person of ordinary skill in the art would not look to a sunscreen composition, which is waterproof, to modify a cleaning composition of Zabotto and/or Barker which can be rinsed away with water. In addition, Stewart does not disclose or suggest (i) that 8% to 20% by weight of the 10% to 45% by weight of the particulate material is a starch material selected from

the group consisting of starches and enzyme or acid hydrolyzed starches or (ii) the addition of calcium or magnesium C₁₄-C₁₈ monocarboxylic salt to the composition, as required by base claim 44.

f. Geria Fails To Solve The Deficiency

The Examiner states: “Geria et al. teaches that pumice is known to be useful as abrasive particles in cosmetic composition. See, particularly, col. 7, lines 25-40.” Office Action at pp. 4-5.

Geria, however, discloses a water and oil skin cleansing composition containing 15% to 65% water, with amounts greater than 20% preferred. The amount of water in this composition far exceeds the 0% to 4% set forth in Applicant’s base claim 44. The amount of the abrasive is from about 2%-10%. Geria makes no mention of any percentage of a starch material to the abrasive, and particularly the 8% to 20% starch material required in the present claims.

Like Kellner, Geria requires an aqueous thickening or gelling agent. Because a gelling agent is required, one of skill in the art would **not** look to an **aqueous** composition requiring a gelling agent to modify an **anhydrous** composition of Zabotto. While Geria discloses pumice as a particulate material, pumice could not be substituted in Barker because Barker requires that the particulate be water soluble and absorbed by the skin. See col. 2:52-58 of Barker. Geria’s composition contains 5% to 9% of a surfactant to leave an oil film on the skin that is a “non-oily film of oil.” See col. 3:55 to col. 4:15.

However, there is no disclosure that such levels of surfactant would be expected to have the same effect in compositions having less than 15% water content. In addition, Geria does not disclose the inclusion of (i) a calcium or magnesium C₁₄-C₁₈ monocarboxylic salt to the composition or (ii) a starch/particulate mixture where 8% to 20% by weight of the 10% to 45%

by weight of the particulate material is a starch material selected from the group consisting of starches and enzyme or acid hydrolyzed starches as required by base claim 44.

g. *Daniel Fails To Solve The Deficiency*

The Examiner states: “Daniel et al. teaches that kernel flour is known to be useful as an abrasive agent in cleansing composition.” Office Action at p. 5.

Daniel does not disclose an emollient composition; rather it is a cleansing agent for removing strongly adhering dirt. Therefore, a person skilled in the art would not look to Daniel to modify an emollient composition, such as disclosed by Zabotto and/or Barker. In addition, the particulate material disclosed in Daniel are very fine particles, much finer than 100-800 μm particles disclosed in Barker and the 50-1000 μm particles disclosed in Zabotto. Further, the reference does not disclose or suggest a composition containing calcium or magnesium $\text{C}_{14}\text{-C}_{18}$ monocarboxylic salt and 0.4% to 8.0% by weight of a surface active agent to form a stable composition and to leave a thin film of emollient material on the skin as required by base claim 44.

h. *Gagnebien Fails To Solve The Deficiency*

The Examiner states: “Gagnebien et al. teaches that macadamia oil is known to be used in cleansing composition. See, particularly, col. 4. lines 35-40.” Office Action at p. 5.

Gagnebien discloses a “FOAMING COMPOSITION FOR CLEANING THE SKIN” that contains an oil component such as macadamia oil and a surfactant. However, the surfactant is a foaming surfactant. Further, the reference fails to disclose a calcium or magnesium salt of a carboxylic acid or an exfoliate particulate material selected from the group consisting of sodium chloride, pumice, talc and vegetable flour as required by base claim 44. The reference also does not disclose the amount of exfoliant to contain 8% to 20% by weight of a starch material in

addition to the particulate material. While Gagnebien's composition includes a surfactant, it is a foaming surfactant.

The claimed product uses a surface active agent that forms a stable composition and leaves a thin film of emollient material on the skin. A foaming surface active agent would not be expected to leave a thin layer of emollient material on the skin. Further, base claim 44 requires that a stable, extrudable paste or cream is formed. (A foaming agent would not provide a stable, extrudable paste or cream. See, Test 1 v. Test 2 Col . 8:1-12.).

Objective indicia of non-obviousness, namely, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts, weigh strongly against a finding of obviousness of claims 44-59. See MPEP § 2141 (III) ("Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present."); *see also Ortho-McNeil Pharm. v. Mylan Labs, Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008) ("[T]his evidence is not just a cumulative or confirmatory part of the obviousness calculus but constitutes independent evidence of nonobviousness"); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983) ("[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record.").

The synergy between the elements of the claimed composition that provides "...which is stable and which does not leave a greasy or tacky after-feel when said composition is applied to and rinsed from skin with water and the skin is dried" provides strong evidence of nonobviousness. MPEP § 2141.01(V) ("[I]n the case of a claim to a combination, applicants

may submit evidence or argument to demonstrate that ...(B) the elements in combination do not merely perform the function that each element performs separately”).

Here, the applicant has presented objective evidence of non-obviousness by the Rule 1.132 declaration of Lauren Trahan to rebut the Examiner-alleged *prima facie* obviousness contentions of the Examiner’s – comparative tests of products embodied by Barker’s composition and the McAtee multilayered product. Further, the specification examples additionally provide evidence of superior results of the claimed invention over other compositions, including the broad ranges for the emollient and surfactant in the claimed composition.

Notwithstanding the lack of a *prima facie* case, the examiner maintained the obviousness rejection even in view of the Trahan Rule 1.132 Declaration that established the inventive product “EP” was “significantly better” than the prior art products, *i.e.*, “NT” Example 1 from Barker; P&G Olay Total Age Defying Cleansing Cloths (McAtee); One Minute Manicure of Mykytyn Enterprises, a bench mark for this category. Declaration at p. 5, ¶ 14. The confidence level was 95 % confidence. Trahan Declaration at p. 5, ¶ 12-p. 6, ¶ 12. The testing conducted by Ms. Trahan presented results of a product evaluation using a test panel of thirty (30) women, who evaluated a product composition within the scope of the claims in the present application to Barker’s composition and the McAtee multilayered product.² Trahan Declaration at pp. 3, ¶ 6 – p. 7, ¶ 14. The formulation of the “EP” product was as follows:

² A comparison to Zabotto could not be reproduced because the ingredients in Zabotto’s composition are no longer commercially available and could not be obtained.

Ingredient	Weight Percent
Macadamia Ternifolia Seed Oil	35.06%
Stearic Acid	0.552%
Butyrospermum Parkii (Shea Butter)	0.72%
Caprylic/Capric Triglyceride	0.48%
Isopropyl Myristate	0.96%
Dow Corning ® 345 Fluid	0.36%
Cetyl Alcohol	0.24%
Emulsifying Wax N.F.	0.96%
Sucrose Distearate	0.24%
Incroquat Behenyl TMS	0.48%
Tauranol WSP	0.95%
Potassium Stearate	0.125%
USP Colloidal Oatmeal	0.99%
Calcium Stearate	18.80%
Maltodextrin	12.20%
Deionized Water	0.80%
Phenonip	1.00%
Bladderwrack Extract	0.033%
Algae Extract	0.033%
Pacific Sea Kelp Extract	0.033%
Fragrance	1.50%
Sodium Chloride	23.49%

Id. The Declaration establishes that Applicant's commercial product, however, is superior to Barker's composition – a primary reference - and McAtee's multilayered dry wipe product – a secondary reference.

The commercial Hand Recovery® product covered by the claims of the present application has been a commercial success for Crabtree & Evelyn as evidenced by the Supplemental Declaration of Lauren Trahan. In the past four (4) years, almost three hundred and ninety thousand (390,000) Hand Recovery® units have been sold. The sales represent at least 2% of the total sales of Crabtree & Evelyn products.

The Examiner indicated that notwithstanding the showing in the Trahan Declaration, the Examiner's position is that it is not commensurate in scope with the claimed subject matter. In

particular, the composition did not cover the broad ranges for the emollient and surfactant in the claimed composition. The Examiner's attention is directed to Examples 1, 7, 20-22 in the specification as further evidence of the scope of the amount of emollient (about 35% to 60%) and the amount of surfactant (0.7 to 8%) produce the conditioning effects set forth in base claim 44.

Example 1 in the specification is substantially similar to the composition as set forth in the Trahan Declaration. The amount of emollient is about 35% in both Example 1 and the Trahan Declaration and the amount of surfactant in Example 1 and the Trahan Declaration is 0.7% and 1%, respectively.

Example 7 describes a composition comprising 41% of an emollient and 4% of a surfactant. Specification at p. 20. The composition is described as being a stable cream and "softens, smoothes and moisturizes the skin when it is applied thereto" These are properties set forth in base claim 44. Compare the properties of Example 7, specification at p. 20, to Exhibits L, M and N of the Trahan Declaration. Examples 20-22 describe compositions containing 45 to 55% emollient and an amount of surfactant ranging from 3.5% to 8%. The compositions are described as forming "substantially stable creams that are effective to soften, smooth, moisturize and cleanse the skin when used in the claimed manner." Specification at p. 24:1-23. Again, these are claimed properties. Also compare these properties to Exhibits L, M and N of the Trahan Declaration. Trahan Declaration at Exhibits L, M and N. Other examples in the specification that support the scope of the claims include Examples 17-19. Specification at p. 23:17-32.

The data from the Trahan Declaration and the Examples from the specification would have led a person of ordinary skill in the art to conclude that there is a reasonable expectation that the results shown in the Trahan Declaration would be expected for the entire range of the

emollient and surfactant contained in the claimed composition set forth in independent claim 44, dependent claims 45, 58 and 59.

Citing *KSR* the Examiner asserted, “[t]he combination of familiar elements according to known methods of is likely to be obvious when it does no more than yield predictable results.” As shown in by the cited references as a whole, all the elements are known in the prior art for their function, The claimed invention yield no more than what predicted by the prior art.” Office Action at p. 8. The Examiner, however, has not considered the prior art references as a whole, and instead, merely selected specific components of the claimed composition from a combination of **eight** references using hindsight reasoning based on the Applicant’s disclosure. The Examiner has not considered the prior art teachings as a whole. The Examiner combined the teachings of disparate references. For example, the Examiner combined teachings based on aqueous compositions, anhydrous compositions, and waterproof compositions, as explained above. As explained in *KSR*, “When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.” *KSR* at 1740. *See also* MPEP § 2143(A). It is readily apparent that the Examiner has ignored the portions of the applied references which teach away from combining the references in order to maintain an untenable rejection.

It is furthermore unobvious to combine the eight asserted references in light of the many possible combinations of elements. A review of Zabotto, Barker, Kellner, McAtee, Stewart, Geria, Daniel, and Gagnebien reveal there are millions of possible combinations of disclosed composition components. Obtaining the claimed composition from the eight cited references by one of ordinary skill in this art would be the equivalent of finding a needle in a haystack. Clearly, one of ordinary skill in this art would not have been lead, by either the references

themselves or common sense, to pick and choose individual elements from the eight cited references to arrive at the claimed cosmetic exfoliating composition. It is clear, that the Examiner's conclusion of obviousness is rooted in impermissible hindsight reasoning in view of Applicant's disclosure.

The dependent claims are allowable for at least the same reasons as claim 44 and further distinguish the claimed cosmetic exfoliating composition. For example, claim 45 further requires that the amount of water in the composition is 0%-1% by weight. Claim 58 further requires the emollient oil is a macadamia seed oil and rice bran oil; the fatty acyl or alkyl group esters are isopropyl myristate, sucrose distearate, and caprylic/capric triglyceride; the fatty alcohol is cetyl alcohol; the fatty acid is stearic acid; the emollient extract is Shea butter; the emollient is emulsifying wax; the surface active agent is sodium cocoyl N-methyl taurate; the monocarboxylic acid salt is calcium stearate; the particulate material is pumice; and the composition contains 0%-1% by weight water. Claim 59 further requires the emollient oil is a macadamia seed oil; the fatty acyl or alkyl group esters are isopropyl myristate, sucrose distearate, and caprylic/capric triglyceride; the fatty alcohol is cetyl alcohol; the fatty acid is stearic acid; the emollient extract is Shea butter; the emollient is emulsifying wax; the surface active agents are sodium cocoyl N-methyl taurate and potassium stearate; the monocarboxylic acid salt is calcium stearate; the particulate material is a mixture of sodium chloride and oat kernel flour; and the composition contains 0%-1% by weight water.

Claim 45 is a dependent claim that depends directly on independent claim 44. Further, in addition to the arguments above, that are hereby incorporated by reference as to Claim 45, the limitations of claim 45 further distinguish the claim invention from the prior art. The prior art applied by the examiner fails not only for the reasons discussed above, but also for the following

reason. By way of illustration, Kellner requires a significant amount of water - 5%-95% by weight - whereas claim 45 has the limitation of "0%-1% by weight water" that is far below the range of Kellner. Further, Geria contains 15% to 65% water, which is far above the 0%-1% by weight water in claim 45.

For the above reasons, the examiner's rationale in applying all eight prior art references to render the invention of claim 45 obvious fails.

Claim 58 is a dependent claim depending directly on independent claim 44. Further, in addition to the arguments presented above as regards claim 44, that are hereby incorporated by reference as to Claim 58, the limitations of claim 58 further distinguish the claimed invention from the prior art. The prior art applied by the examiner fails not only for the same reasons as regards claim 44, but also for the following reasons. By way of illustration, Kellner requires a significant amount of water - 5%-95% by weight - whereas claim 58 has the limitation of "0%-1% by weight water" that is far below the range of Kellner. Geria fails to recite a particulate of pumice, as required by claim 58. In addition, the cited references do not suggest the combination of each of the specific components recited in claim 58.

For the above reasons, the examiner's rationale in applying all eight prior art references to render the invention of claim 58 obvious fails.

Claim 59 is a dependent claim that depends directly on independent claim 44. Further, in addition to the arguments as regards claim 44, that are hereby incorporated by reference as to Claim 59, the limitations of claim 59 further distinguish the claim invention from the prior art. The prior art applied by the examiner fails not only for the reasons discussed above, but also for the following reasons. By way of illustration, Kellner requires a significant amount of water - 5%-95% by weight - whereas claim 59 has the limitation of "0%-1%

by weight water” that is far below the range of Kellner. Further, Geria contains 15% to 65% water, which is far above the 0%-1% by weight water in claim 59. Also, Geria fails to recite a particulate of sodium chloride and oat kernel flour as required by claim 59. In addition, the cited references do not suggest the specific combination of components of claim 59.

As indicated below, claim 59 substantially reflects the elements of product “EP” that was significantly superior over the prior art products in the Trahan Rule 1.132 Declaration. The water weight percent of “0.80%” is bounded by the claim 59 limitation of water content (weight per cent from 0% to 1%). This evidence of “significantly superior” results of the EP product over the closest prior art fully rebuts the examiner’s assertion of obviousness.

Ingredient	Weight Percent	Claim 59
Macadamia Ternifolia Seed Oil	35.06%	Yes
Stearic Acid	0.552%	Yes
Butyrospermum Parkii (Shea Butter)	0.72%	Yes
Caprylic/Capric Triglyceride	0.48%	Yes
Isopropyl Myristate	0.96%	Yes
Dow Corning ® 345 Fluid	0.36%	Yes
Cetyl Alcohol	0.24%	Yes
Emulsifying Wax N.F.	0.96%	Yes
Sucrose Distearate	0.24%	
Incroquat Behenyl TMS	0.48%	
Tauranol WSP	0.95%	Yes
Potassium Stearate	0.125%	Yes
USP Colloidal Oatmeal	0.99%	Yes
Calcium Stearate	18.80%	Yes
Maltodextrin	12.20%	
Deionized Water	0.80%	Yes
Phenonip	1.00%	
Bladderwrack Extract	0.033%	
Algae Extract	0.033%	
Pacific Sea Kelp Extract	0.033%	
Fragrance	1.50%	
Sodium Chloride	23.49%	Yes

For the above reasons, the examiner's rationale in applying all eight prior art references to render the invention of claim 59 obvious fails.

New claims 60 and 61 are further distinguishable over the cited prior art. Claims 60 and 61 are presented in view of the December 8, 2009 telephone interview. The Examiner maintained that the claims were too broad during the interview. New claims 60 and 61 are directed to the same invention as claim 44, but the composition components are further specified. Applicant submits that it would not have been obvious for one of ordinary skill in this art to select all the specifically claimed composition

Application No.: 09/964,143

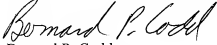
components from the disclosures of the cited references to arrive at the compositions of new claims 60 and 61.

In view of the above amendments and remarks, the Declaration Under 37 C.F.R. § 1.132, and the Supplemental Declaration Under 37 C.F.R. § 1.132 by Lauren Trahan, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Bernard P. Codd
Registration No. 46,429

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BPC:MWE
Facsimile: 202.756.8087
Date: December 23, 2009

**Please recognize our Customer No. 20277
as our correspondence address.**